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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/754,553

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Patrice Aguilera

43315-201407

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10/23/2006

VENABLE LLP

P.O. BOX 34385

WASHINGTON, DC 20043-9998

EXAMINER

BUCHANAN, CHRISTOPHER R

ART UNIT

PAPER NUMBER

3671

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/754,553

Applicant(s)

AGUILERA, PATRICE

Examiner

Christopher R. Buchanan

Art Unit

3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 4-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 31, 2006 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pokladnik et al. (US 4,438,817) alone.

Regarding claim 1, Pokladnik discloses a subsea oil and/or gas exploitation device including a guide member (12, Fig. 3) operative to guide subsea equipment (22) that is to be landed and connected to the device into a connecting position in relation to the device, wherein the guide member comprises an array of generally vertically extending projections (36, 37, 38, 39) that extend above the guide member and are

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operative to engage corresponding recesses (bottom of 81, 82, 83, 84) arranged in a corresponding guide member (81-84) on the subsea equipment by extending into the recesses (col. 5 line 50+).

The device of Pokladnik differs from the claimed invention in that the projections of the guide member do not extend through the recesses of the corresponding guide member located on the subsea equipment, but extend into the recesses (claim 1). However, the projections in the device of Pokladnik achieve the same result, i.e., connecting the subsea equipment to the device, thus they act as a functional equivalent. Furthermore, the guide members of the device and equipment could attach to each other in a variety of manners and the manner recited in the claims would be considered a design choice since it does not solve any stated problem or serve any particular purpose.

Regarding claim 2, each projection (36, 37, 38, 39) has a tapered end portion (Fig. 1). Regarding claim 15, the projections (36, 37, 38, 39) are arranged circumferentially around a center axis of the guide member (Fig. 1). Regarding claim 16, the projections (36, 37, 38, 39) are evenly angularly distributed around a center axis of the guide member (Fig. 1). Regarding claim 17, the device is a base device that is to be located on the sea bottom (column 3 lines 4-5). Regarding claim 18, the device defines a well template and the equipment to be seated thereon comprises a Christmas tree (22). Regarding claims 19 and 20, it would be obvious to one of ordinary skill in the art that the device could be a variety of components, including a blow out preventer, pump, separator, etc.

4. Claims 5-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pokladnik et al. (US 4,438,817) alone.

Regarding claim 5, Pokladnik discloses a subsea oil and/or gas exploitation device including a guide member (12, Fig. 3) operative to guide subsea equipment (22) that is to be landed and connected to the device into a connecting position in relation to the device, wherein the guide member comprises an array of generally vertically extending projections (36, 37, 38, 39) that extend above the guide member and are operative to engage corresponding recesses (bottom of 81, 82, 83, 84) arranged in a corresponding guide member (81-84) on the subsea equipment by extending into the recesses (col. 5 line 50+).

The device of Pokladnik differs from the claimed invention in that the guide member located on the device does not include an array of recesses and the guide member located on the subsea equipment does not include corresponding vertically extending projections and in that the projections of the guide member do not extend through the recesses of the corresponding guide member, but extend into the recesses (claim 5). However, the guide members and the projections in the device of Pokladnik achieve the same result, i.e., connecting the subsea equipment to the device, thus they act as a functional equivalent. Furthermore, the guide members of the device and equipment could attach to each other in a variety of manners and the manner recited in the claims would be considered a design choice since it does not solve any stated problem or serve any particular purpose. It would be obvious to one of ordinary skill in

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the art at the time the invention was made that the guide member having recesses could be located on the device and the guide member having the projections could be located on the subsea equipment, and vice versa, and the same result would be achieved.

Regarding claim 6, the recesses are provided by a cone-shaped, hollow body on the guide member (see Fig. 3). Regarding claim 7, the hollow body defines a funnel. Regarding claim 8, the projections and recesses are arranged circumferentially around a center axis of the guide member (Fig. 1). Regarding claim 9, the projections and recesses are evenly angularly distributed around a center axis of the guide member (Fig. 1). Regarding claim 10, the device is a base device that is to be located on the sea bottom (column 3 lines 4-5). Regarding claim 11, the device defines a well template and the equipment to be seated thereon comprises a Christmas tree (22). Regarding claim 12, the device includes a plurality of guide members. Regarding claims 13 and 14, it would be obvious to one of ordinary skill in the art that the device could be a variety of components, including a blow out preventer, pump, separator, etc.

5. Claims 4, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pokladnik et al. (US 4,438,817) in view of Rytlewski et al. (US 6,231,265).

Pokladnik discloses a device as described above. Pokladnik fails to disclose each projection comprising an outer layer of a low-friction material, preferably a polymer, and most preferably poly-tetra-fluor-ethylene.

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Like Pokladnik, Rytlewski discloses mating subsea devices, including a first component having a projection (112) for insertion into a recess (64) of a second component (column 4 lines 9-11). Unlike Pokladnik, Rytlewski discloses coating the surface of the projection (112) with a low-friction material (claim 4), the low-friction material being polymer poly-tetra-fluor-ethylene (column 4 lines 25-27) (claims 21 and 22).

Given the suggestion in Rytlewski, it would have been obvious to one of ordinary skill in the art to modify the device of Pokladnik as taught in Rytlewski to minimize friction between the two components so that maintenance and repair costs due to damage and wear are reduced.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1, 2, and 4-22 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

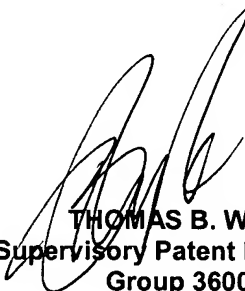
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Buchanan whose telephone number is 571-272-8134. The examiner can normally be reached on Mon.-Fri. 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Will can be reached on 571-272-6998. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CB



**THOMAS B. WILL**  
Supervisory Patent Examiner  
Group 3600